

## REMARKS

This responds to the Office Action mailed on October 8, 2008.

Claims 1, 11-12, 21-22, 31, and 32 are amended. Claims 2, 13, and 23 are canceled, and no claims are added. As a result, claims 1, 3-12, 14-22, and 24-32 are now pending in this application.

### §102 Rejection of the Claims

Claims 1-3, 9-14, 19-24 and 29-32 were rejected under 35 U.S.C. § 102(e) for anticipation by Dettinger et al. (U.S. Patent No. 6,947,928, hereinafter; "Dettinger"). To anticipate a claim, the reference must teach every element of the claim.<sup>1</sup> Applicants respectfully submit that the cited reference does not support a *prima facie* case of anticipation,<sup>2</sup> because the cited reference fails to teach every element of Applicants' claimed subject matter.

As currently amended, independent claims 1, 12, 22, and 32 recite, in part, "second search criteria including at least two attribute parameters," "each . . . selectively includable and excludable . . . through the search interface," and "an option . . . through the search interface to selectively build a search query using the first search criteria only, the second search criteria only, or the first and second search criteria combined."<sup>3</sup>

Figures 5 and 7 of Dettinger are illustrative of a search interface according to Dettinger. Assuming, without agreement, that "(Date of Birth <= 1942/01/01)"<sup>4</sup> constitutes "first search criteria" and "(gender = male)"<sup>5</sup> constitutes "second search criteria," the second search criteria does not "includ[e] at least two attribute parameters." On the other hand, assuming, also

<sup>1</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, "[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983) (emphasis added).

<sup>2</sup> "[T]he exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 U.S.P.Q. 781, 789 (Fed Cir. 1983). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

<sup>3</sup> Claims 1, 12, 22, and 32, italics added, underlining omitted hereafter.

<sup>4</sup> Dettinger, Fig. 5, near ref. 402. *See also, id.*, Fig. 7, ref. 702.

<sup>5</sup> *Id.*, Fig. 5, near ref. 506.

without agreement, that "(gender = male) AND (hemoglobin <= 5),"<sup>6</sup> shown as one search condition in Figure 7 of Dettinger, constitutes "second search criteria including at least two attribute parameters," the attribute parameters are not "*each . . . selectively includable and excludable* from the second search criteria *through the search interface*." Furthermore, assuming, again without agreement, that "(gender = male)"<sup>7</sup> and "(hemoglobin <= 5),"<sup>8</sup> shown as separate search conditions in Figure 5 of Dettinger, constitute "second search criteria including at least two attribute parameters," Dettinger nonetheless fails to disclose "*an option . . . to selectively build a search query using the first search criteria only, the second search criteria only, or the first and second search criteria combined*." Thus, Dettinger fails to disclose at least one of these three elements.

Because each and every element of independent claims 1, 12, 22, and 32 is not set forth in the cited reference, no *prima facie* case of anticipation is established. For at least these reasons, claims 1, 12, 22, and 32, and their respective dependent claims, are asserted to be patentable. Therefore, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

#### §103 Rejection of the Claims

Claims 1-3, 9-14, 19-24 and 29-32 were rejected under 35 U.S.C. § 102(e) for anticipation by Dettinger in view of Beibesheimer (U.S. Publication No. 2002/0152190, hereinafter, "Beibesheimer"). A determination of obviousness requires a factual showing that "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."<sup>9</sup>

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined.<sup>10</sup>

Applicants respectfully submit that the Office Action does not establish a determination of obviousness, for the reason that the scope and content of the cited references, even if combined,

---

<sup>6</sup> *Id.*, Fig. 7, ref. 704.

<sup>7</sup> *Id.*, Fig. 5, near ref. 506.

<sup>8</sup> *Id.*, Fig. 5, near ref. 508.

<sup>9</sup> *Graham v. John Deere*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

<sup>10</sup> *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ 82 U.S.P.Q.2d 1385 (2007).

do not teach or suggest Applicants' claimed subject matter or support rational inferences that one skilled in the art would be reasonably expected to draw to reach Applicants' claimed subject matter.

As noted above, Dettinger fails to disclose at least one element recited in each of independent claims 1, 12, 22, and 32. Beibesheimer is directed to "resource search and selection" in a "customer self service system."<sup>11</sup> Applicants, however, cannot find within Beibesheimer any disclosure of the at least one element shown to be absent from Dettinger.

Beibesheimer mentions "include" and "exclude" only in the context of "resource parameters." For example, Figure 5 of Beibesheimer depicts a "Home Location" interface containing checkboxes to "include" or "exclude" various "resource parameters."<sup>12</sup> These resource parameters, however, are not "search criteria," as recited in claims 1, 12, 22, and 32. Beibesheimer expressly states that "the user may change or create *resource parameters* using *include* logic or *exclude* logic for any *context attribute* value selected in the workspace."<sup>13</sup> Beibesheimer explicitly defines "context attribute" as something other than search criteria.

Particularly, a user context represents a predefined set of *context attributes which are relevant to the search behavior/needs of a group of users*. For example, as described herein, context may include aspects of the user's knowledge, and their relationship to organizers and/or communities, the user environment(s), and the resource need. All of these combine to provide a rich context *surrounding the actual query* . . .<sup>14</sup>

As specifically defined in Beibesheimer, the context attributes are "*surrounding the actual query*." Therefore, the context attributes of Beibesheimer are not part of the "*actual query*," and accordingly cannot constitute "search criteria," as recited in claims 1, 12, 22, and 32.

Figure 5 of Beibesheimer also depicts various "resource selection criteria values" that may be given a numerical "weight," which sharply contrasts with inclusion and exclusion of search criteria. Nothing in Beibesheimer suggests that "resource selection criteria values" constitute "search criteria," much less "second search criteria." Beibesheimer discusses these "resource selection criteria values" only in the context of "weight[ing]" or "rank[ing]," and not

<sup>11</sup> Beibesheimer, abstract.

<sup>12</sup> *Id.*, Fig. 5, refs. 237 and 239.

<sup>13</sup> *Id.*, paragraph [0070], emphasis added, references omitted.

<sup>14</sup> *Id.*, paragraph [0064], emphasis added.

"searching" or "querying."<sup>15</sup> Assuming, without agreement, that the resource selection criteria values together somehow constitute "second search criteria including at least two attribute parameters," and further assuming, again without agreement, that assigning zero weight would act to "exclude" a resource selection criteria value and that assigning non-zero weight would act to "include" a resource selection criteria value, Beibesheimer nonetheless fails to disclose "*an option . . . to selectively build a search query using the first search criteria only, the second search criteria only, or the first and second search criteria combined.*" Thus, Beibesheimer fails to disclose at least this element.

As a result, the scope and content of the cited references, even if combined, fail to teach or suggest Applicants' claimed subject matter or support rational inferences that one skilled in the art would be reasonably expected to draw to reach Applicants' claimed subject matter. For at least these reasons, claims 1, 12, 22, and 32, and their respective dependent claims, are asserted to be patentable over Dettinger in view of Beibesheimer. Therefore, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

Claims 4-8, 15-18 and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dettinger in view of Beibesheimer and in further view of Monahan et al. (U.S. Patent No. 6,523,035, hereinafter; "Monahan"). Monahan discusses an interface to communicate a "selected subset of a search result set."<sup>16</sup> Applicants, however, cannot find within Monahan any disclosure of the at least one element shown to be absent from Dettinger and Beibesheimer. As a result, the scope and content of the cited references, even if combined, fail to teach or suggest Applicants' claimed subject matter or support rational inferences that one skilled in the art would be reasonably expected to draw to reach Applicants' claimed subject matter. For at least these reasons, claims 1, 12, 22, and 32, and their respective dependent claims (e.g., claims 4-8, 15-18, and 25-28), are asserted to be patentable over Dettinger in view of Beibesheimer and in further view of Monahan. Therefore, Applicants respectfully request that these rejections be withdrawn and the claims be allowed.

---

<sup>15</sup> See, e.g., *id.*, Fig. 5; paragraph [0048] ("sub-process 34 *weights* and *ranks* the potential responses according to the resource selection criteria"); paragraph [0060] ("Parameters and specifications for ranking a user's response set . . ."); emphasis added.

<sup>16</sup> E.g., Monahan, col. 11, lines 38-40; Figs. 12A and 13.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (408) 278-4048 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(408) 278-4048

Date January 6, 2008

By /

  
Joseph J. Wang  
Reg. No. 61,123

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 6, 2009.

Name (HVIS BART)

Signature (CJW)